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EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,184

Applicant(s)

ISHIZUKA, TATSUYA

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/931,847.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/16/03</u> | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The disclosure is objected to because of the following informalities: the status of the parent case in the first paragraph of the specification needs to be updated.

Appropriate correction is required.

Note

2. Claims 1-6, 16 and 17 are product by process claims. Product by Process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. However, the structure implied by the steps should be considered when assessing the patentability of product-by-process claims where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. The structure implied by the “consideration” step of claim 1 (lines 3-6) and the “determining” step of claim 2 (lines 5-11) is essentially a “space” between certain elements. This is how the claims will be interpreted with respect to prior art structure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuma et al. (U.S. Pat. 6,547,721).

Referring mainly to Figure 22, Higuma et al. disclose a push-button switch (13) including a switch (148) capable of being autoclaved, and a pressing member (150,149) that shields the switch to keep it watertight (col.25, lines 34-36), includes a presser (149), can at least partly deform, and can be displaced in a direction in which the switch is pressed. A space exists between the presser (149) and the switch (148). Thus, the structural limitations of claim 2 are met. Claims 3-5 offer no new structural limitations but reaffirms what is inherently known--the distance between the presser and the switch has a "value". As to claim 6, note linking means (20) in Figure 2. As to claim 16, note waterproof film (150). Since the waterproof film (150) meets the limitation of a soft barrier for separating an interior from an exterior, there is a space between the barrier and at least one other element, and nothing in Higuma et al. is disclosed as being "broken" upon displacement of the barrier, the structural limitations of claim 1 are also met.

5. Claims 1-5, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Donofrio et al. (U.S. Pat. 6,608,270).

Donofrio et al. disclose a push-button switch (Fig.2) including a switch (details best seen in Figure 11), a pressing member (82, Fig.2), a presser (87, Fig.4) and a space between the presser and switch (seen in Figure 2 but best shown in Figure 11). Pressing member (82) forms a soft barrier and is spaced from other elements. Pressing member comprises a waterproof film (col.5, lines 1-3) and can include a coil spring (col.8, lines 61-64).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Pat. 5,658,238) in view of Taylor (U.S. Pat. 4,021,630).

Referring mainly to Figure 9, Suzuki et al. disclose a push-button switch including a switch (45a,45b), a pressing member (33a), a presser (45c), a space between the presser and switch (Fig.9), and a spring (43). Suzuki et al. fails to disclose that the pressing member keeps the switch watertight or is waterproof in itself. If not inherent from its intended use (medical procedures often fluids, either from the body or from equipment), it would have been obvious to one of ordinary skill in the art to have made the switch watertight, using waterproof materials, to protect the internal switch components from corrosion and contamination. Watertight or waterproof switches are known in the surgical art as evidenced by the multiple references cited in this Office Action, and the level of ordinary skill would necessitate knowledge of this concept due to the nature of medical procedures. Taylor evidences that such concept is old and well known (col.1, lines 24-32).

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hosono et al. (U.S. Pat. 4,341,205)

Jarrard (U.S. Pat. 3,911,241)

Higuma et al. (U.S. Pat. 6,716,161)

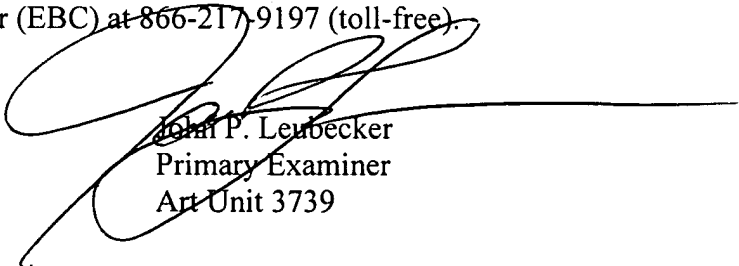
Chikama (U.S. Pat. 4,986,257)

Akiba (U.S. Pat. 6,561,971)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl